

REMARKS

Claims 1 to 26 were pending in the application at the time of examination. Claims 1 to 26 stand rejected as anticipated. Claims 11, 12, and 26 stand rejected as obvious.

Applicant(s) have amended the description to correct a grammatical error.

In the replacement sheets of drawings, minor informalities have been corrected such as lines going through reference numerals, etc.

To more clearly recite the invention, Claims 1, 13, and 25 have been amended. In particular these claims have been clarified to recite that the text is user selected and that the user selected text is in the computer-generated document. These features were inherent in the elements in the original claims. Also, the limitations of Claim 6 have been incorporated in Claim 1 and the limitations of Claim 18 incorporated in Claim 13. Accordingly, Claims 6 and 18 have been canceled. Claim 25 has been amended to include limitations similar to those in claims 1 and 13. Claim 25 also has been amended to correct an informality.

Claims 3, 7, 15, and 19 have been amended to correct an informality introduced by the amendment to the independent claim upon which each depends.

Claim 14 is amended to correct a typographical error. This amendment does not affect the patentability of the claim.

Claims 23 and 24 have been canceled.

Claims 1 to 10 and 13 to 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,251,292, hereinafter Martel. The Examiner stated in part:

converting a selected text portion of said computer-generated document containing at least one text instruction symbol into a data object (see Figures 1-2; see Column 1, Line 1 through Column 26, line 34--the

"selected text portion" of the document is that portion entered into the equation editor . . .)

Applicant respectfully traverses the anticipation rejection of Claim 1. The Examiner admits that Martel taught using a text editor and entering the information directly into the text editor. Thus, Martel is similar to the prior art cited by Applicant. In contrast, the user selected text is "in the computer generated document" and not in an equation editor as in Martel.

For an anticipation rejection, the MPEP requires:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

. "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

MPEP §2131, 8th Ed., Rev. 2, p. 2100- 73 (May 2004).

Since Martel fails to show "the identical invention," Martel fails to anticipate Claim 1. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 1 in view of Martel.

Applicant traverses the anticipation rejection of each of Claims 2 to 5 and 7 to 10 in view of Martel. Claims 2 to 5 and 7 to 10 depend from Claim 1 and so each claim distinguishes over Martel for at least the same reasons as Claim 1. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claims 2 to 5 and 7 to 10 in view of Martel.

Applicant respectfully traverses the anticipation rejection of Claim 13. The Examiner rejected Claim 13 for the

same reasons as quoted above for Claim 1. Since Claim 13 includes a limitation similar to that discussed above with respect to Claim 1, the above comments with respect to Claim 1 and Martel are applicable to Claim 13 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 13 in view of Martel.

Applicant traverses the anticipation rejection of each of Claims 14 to 22. Claims 14 to 22 depend from Claim 13 and so each claim distinguishes over Martel for at least the same reasons as Claim 13. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claims 14 to 22 in view of Martel.

Claims 6, 18, 23 and 24 have been canceled. Thus, the anticipation rejection of these claims in view of Martel has been rendered moot.

Applicant respectfully traverses the anticipation rejection of Claim 25. The Examiner rejected Claim 25 for the same reasons as quoted above for Claim 1. Since Claim 25 includes a limitation similar to that discussed above with respect to Claim 1 and Martel, the above comments with respect to Claim 1 and Martel are applicable to Claim 25 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 25 in view of Martel.

Claims 1 to 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Tittel, Ed. et al., HTML for Dummies, IDG Books Worldwide, Inc. (1998), hereinafter Tittel. Applicant respectfully traverses the anticipation rejection of Claim 1 in view Tittel.

HTML is known to be a programming language. Further, when a web page is processed, the entire web page is converted. There is no teaching or suggestion of selectively handling only a portion of the web page. The Examiner has failed to cite any

teaching of a conversion of the Examiner's example based upon a user selection. Accordingly, Tittel fails to show "the identical invention," as recited in Claim 1. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 1 in view of Tittel.

Applicant traverses the anticipation rejection of each of Claims 2 to 5 and 7 to 12. Claims 2 to 5 and 7 to 12 depend from Claim 1 and so each claim distinguishes over Tittel for at least the same reasons as Claim 1. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claims 2 to 5 and 7 to 12 in view of Tittel.

Applicant respectfully traverses the anticipation rejection of Claim 13 in view of Tittel. The Examiner rejected Claim 13 for the same reasons as discussed above for Claim 1 in view of Tittel. Since Claim 13 includes a limitation similar to that discussed above with respect to Claim 1, the above comments with respect to Claim 1 and Tittel are applicable to Claim 13 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 13 in view of Tittel.

Applicant traverses the anticipation rejection of each of Claims 14 to 22 in view of Tittel. Claims 14 to 22 depend from Claim 13 and so each claim distinguishes over Tittel for at least the same reasons as Claim 13. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claims 14 to 22 in view of Tittel.

Claims 6, 18, 23 and 24 have been canceled. Thus, the anticipation rejections of these claims in view of Tittel have been rendered moot.

Applicant respectfully traverses the anticipation rejection of Claim 25 in view of Tittel. The Examiner rejected Claim 25 for the same reasons as discussed above for Claim 1 in view of Tittel. Since Claim 25 includes a limitation similar to that discussed above with respect to Claim 1, the above

comments with respect to Claim 1 and Tittel are applicable to Claim 25 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 25 in view of Tittel.

Applicant traverses the anticipation rejection of Claim 26 in view of Tittel. Claim 26 depends from Claim 25 so each claim distinguishes over Tittel for at least the same reasons as Claim 25. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 26 in view of Tittel.

Claims 1 to 10 and 13 to 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by Aitken, Peter, Sams Teach Yourself Microsoft Word 2000, Sams Publishing (April 28, 1999 hereinafter Aitken. Applicant respectfully traverses the anticipation rejection of Claim 1 in view Aitken.

The AutoCorrection Feature of Word 2000 cited by the Examiner does not require user selection of text. It occurs automatically whenever the particular character sequence is entered by the user. Further, the AutoCorrection feature does not function on a selection that includes "at least one text instruction symbol and at least one text character, which is not included in said text instruction symbol." Accordingly, Aitken fails to show "the identical invention," as recited in Claim 1. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 1 in view of Aitken.

Applicant traverses the anticipation rejection of each of Claims 2 to 5 and 7 to 10. Claims 2 to 5 and 7 to 10 depend from Claim 1 and so each claim distinguishes over Aitken for at least the same reasons as Claim 1. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 2 to 5 and 7 to 10 in view of Aitken.

Applicant respectfully traverses the anticipation rejection of Claim 13 in view of Aitken. The Examiner rejected Claim 13 for the same reasons as discussed above for Claim 1 in view of Aitken. Since Claim 13 includes a limitation similar

to that discussed above with respect to Claim 1, the above comments with respect to Claim 1 and Aitken are applicable to Claim 13 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 13 in view of Aitken.

Applicant traverses the anticipation rejection of each of Claims 14 to 22 in view of Aitken. Claims 14 to 22 depend from Claim 13 and so each claim distinguishes over Aitken for at least the same reasons as Claim 13. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 14 to 22 in view of Aitken.

Claims 6, 18, 23 and 24 have been canceled. Thus, the anticipation rejections of these claims in view of Aitken have been rendered moot.

Applicant respectfully traverses the anticipation rejection of Claim 25 in view of Aitken. The Examiner rejected Claim 25 for the same reasons as discussed above for Claim 1 in view of Aitken. Since Claim 25 includes a limitation similar to that discussed above with respect to Claim 1, the above comments with respect to Claim 1 and Aitken are applicable to Claim 25 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 25 in view of Aitken.

Claims 11, 12, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martel. In each obviousness rejection, the Examiner apparently adds features to Martel, without citation to any other prior art source. Assuming arguendo that this is correct, the additional information fails to overcome the deficiency in Martel, as noted above with respect to the Claims upon which these claims depend. Applicant requests reconsideration and withdrawal of this obviousness rejection of each of Claims 11, 12, and 26.

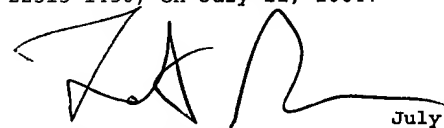
Claims 11, 12, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Aitken. Again, in each

obviousness rejection, the Examiner apparently adds features to Aitken, without citation to any other prior art source. Assuming arguendo that this is correct, the additional information fails to overcome the deficiency in Aitken, as noted above with respect to the Claims upon which these claims depend. Applicant requests reconsideration and withdrawal of this obviousness rejection of each of Claims 11, 12, and 26.

Claims 1 to 5, 7 to 17, 19 to 22, 25, and 26 remain in the application. Claims 1, 3, 7, 13, 14, 15, 19, and 25 have been amended. Claims 6, 18, 23 and 24 were canceled. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 21, 2004.



Attorney for Applicant(s)

July 21, 2004
Date of Signature

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